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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/303,632	05/03/1999	CHERYL B. LEBEAU	D-7102	8616
44885	7590	09/17/2010		
ARTHUR G. YEAGER, Esq. 1301 Riverplace Boulevard Suite 1916 JACKSONVILLE, FL 32207			EXAMINER EVANISKO, LESLIE J	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 09/17/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/303,632

**Applicant(s)**

LEBEAU ET AL.

**Examiner**

Leslie J. Evanisko

**Art Unit**

2854

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21, 25-32, 37, 38, 41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) 27, 30, 31 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 25, 26, 28, 29, 32, 37, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Election/Restrictions**

1. Claims 27, 30, 31, and 38 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 24, 2007.

### **Drawings**

2. The replacement sheets of drawings were received on December 20, 2006. These drawings have been approved by the Examiner.

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Piazze et al. (US 2,773,285).

With respect to claim 21, Piazze et al. teach a package (i.e., roll in Fig. 2) of individual disposable sterile transparent bags or “covers,” 10 each cover consisting of a flat and entirely transparent planar sheet of pliable plastic film of uniform thickness

throughout and a predetermined size in length and width. See, Figures 1 and 2 and column 2, lines 12-31 in particular. Additionally, it is noted that Piazze et al. teach the “covers” can be used “for enclosing commodities which are intended to be kept substantially free of bacterial, fungicidal, or other contamination” in column 1, lines 56-67 and column 3, lines 20-27.

Note that although Piazze et al. do not specifically teach the cover is used for covering a keyboard, note that the claim is drawn to the cover structure per se and not the combination of the cover and keyboard. Therefore, the claim language regarding how the cover is used is merely the intended use of the cover and the claim language does not structurally distinguish from the container of Piazze et al. Thus, Piazze et al. teach a “cover” including all of the structure as recited and is capable of being used to cover a keyboard as recited.

Furthermore, it is noted that the majority of the claim language in claim 21 (such as the language regarding the cover being capable of inhibiting unintentional contact, not impeding the operator’s ability to manipulate the keyboard, the cover configured to contact and entirely protect the keyboard surfaces, and the cover maintaining the keyboard sterile and uncontaminated) are merely functional recitations of desired modes of operation. Again, since Piazze et al. teach a “cover” having all of the structural elements as recited, it is capable of providing those functions and meets the claim language as recited.

With respect to claim 25-26, note that Piazze et al. teach a sheet including an upper member and lower member formed as an envelope with only one elongated

opening along a top edge portion so as to be capable of contacting and protecting the entire upper surface and lower surface of a keyboard as broadly recited.

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as obvious over Piazza et al. (US 2,773,285).

With respect to claims 28 and 29, note that Piazza et al. teach the sterile cover is comprised of two identical flat rectangular members, each member having an elongated top edge portion, an elongated bottom edge portion, and two side edge portions, the flat

members being fastened together along the two side edge portions (via the longitudinal seals) so as to be closed and along the elongated bottom edge portion (via the transverse seal 11) with an opening formed (via unsealed portion) along the elongated top edge portion that is capable of permit a keyboard to be inserted therein as recited. See, column 3, lines 13-19 of Piazza et al. in particular. Note that although Piazza et al. does not necessarily show in the Figures that the rectangular members are oriented or arranged such that the opening is formed along an “elongated” top edge (which is longer than the “short” side edges), Piazza et al. teach that the members are heat sealed transversely at spaced intervals and the spacing of the interval may be varied as necessary to provide covers of any desired size or capacity (see, column 3, lines 1-6). Therefore, it would have been obvious to one of ordinary skill in the art to provide the rectangular members of any desired size and to create the transverse heat seals at such intervals so as to create rectangular covers of the desired size and configuration (such as having an elongated top edge portion, an elongated bottom edge portion and two short side edge portions, the bottom edge and side edges being fastened together such that one long opening is formed along the top edge) so as to best fit over the object desired to be protected.

8. Claims 32, 37, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Piazza et al. (US 2,773,285).

With respect to claim 32, Yanagisawa teaches a keyboard and an individual disposable transparent cover 34, 34' for protecting the sterility of and preventing contaminations between dental or medical patients, the cover comprising a flat and

entirely transparent planar sheet of pliable film of uniform thickness and a predetermined size in length and width for forming an envelope or enclosure (column 11, lines 36-37) for enclosing the entire upper and lower surfaces of the keyboard as recited. See Figures 9-10 and column 11, lines 21-67 in particular. Note that the disposable cover of Yanagisawa is broadly capable of being disposed of after each patient as recited. Additionally, the keyboard of Yanagisawa is rectangular as shown in Figure 6 and therefore, it would appear that the sheet for enclosing the entire keyboard would also be rectangular with long top and bottom edges and short side edges forming an envelope as recited. Although Yanagisawa is silent with respect to the particular details of the enclosure configuration, note Piazza et al. teach an individual transparent sterile "cover" 10 consisting of a flat and entirely transparent planar sheet of pliable plastic film of uniform thickness throughout and having a predetermined size in length and width, the sheet being rectangular and having a long top edge portion, a long bottom edge portion, and two short side edge portions, the sheet being formed as an envelope into which an object may be placed to cover and protect the object from bacterial, fungicidal or other contamination while allowing a user to clearly view the object. Note the previous comments with respect to claims 21, 25 and 26 above. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the "cover" of Piazza et al. as the enclosure for the keyboard of Yanagisawa to provide a simple and easily replaceable sterile cover for better protection of the keyboard.

With respect to claim 37, note Yanagisawa as modified by Piazza et al. teach the keyboard and cover as recited with the possible exception of the envelope having an elongated opening along the long top edge portion with the bottom edge and side edges

being closed. However, the exact size and configuration of the enclosure and the particular edge in which the opening is formed for insertion of object such as a keyboard appears to involve simply a matter of design choice. Therefore, it would have been obvious to one of ordinary skill in the art to provide the cover member of Piazze et al. to be sized and configured as an envelope with an elongated opening along any desired edge, such as a top edge portion, while the other edges are closed to provide a flexible transparent cover for use in a sterile environment with an opening for allowing insertion of the keyboard inside the enclosure.

With respect to claims 41 and 42, note Yanagisawa as modified by Piazze et al. teach a keyboard and a disposable transparent sterile cover including sheet members of pliable plastic film of uniform thickness throughout and a predetermined size in length and width. Note the previous comments with respect to claims 32 and 37 in particular.

Again, it is noted that Piazze et al. teach the cover is comprised of two identical flat rectangular members, each member having an elongated top edge portion, an elongated bottom edge portion, and two side edge portions, the flat members being fastened together along the two side edge portions (via the longitudinal seals) so as to be closed and along the elongated bottom edge portion (via the transverse seal 11) with an opening formed (via unsealed portion) along the elongated top edge portion that is capable of permit a keyboard to be inserted therein as recited. See, column 3, lines 13-19 of Piazze et al. in particular. Note that although Piazze et al. does not necessarily show in the Figures that the rectangular members are oriented or arranged such that the opening is formed along an “elongated” top edge (which is longer than the “short” side edges), Piazze et al. teach that the members are heat sealed transversely at spaced



intervals and the spacing of the interval may be varied as necessary to provide covers of any desired size or capacity (see, column 3, lines 1-6). Therefore, it would have been obvious to one of ordinary skill in the art to provide the rectangular members of any desired size and to create the transverse heat seals at such intervals so as to create rectangular covers of the desired size and configuration (such as having an elongated top edge portion, an elongated bottom edge portion and two short side edge portions, the bottom edge and side edges being fastened together such that one long opening is formed along the top edge) so as to best fit over the object desired to be protected, such as the keyboard of Yanagisawa.

### **Response to Arguments**

9. Applicant's arguments filed August 20, 2010 have been fully considered but they are not persuasive of any error in the above rejections.

In particular applicant argues that Piazze does not teach individual disposable sterile covers because the bags of Piazze are provided in a roll and are adapted to be detached one by one by cutting along dotted lines when they are desired for use. Applicant argues that this cutting action would result in the bags to be non-sterile. The Examiner disagrees with this argument. Firstly, it is mere speculation by the applicant that the bags of Piazze would be non-sterile after the cutting since it would depend upon the environment and conditions in which the bag is being cut. For example, what if the bag is being cut in a sterile environment with sterile tools? Regardless, it is noted that everything that is exposed to air would be non-sterile to some extent since air contains various airborne germs and microorganisms. Thus, as soon as the cover is removed

from its packaging or container during use and exposed to air, the sterility of the cover may be compromised. It is further noted by the Examiner that applicants covers therefore would also appear to be non-sterile to some extent (such as when they are attached to or enveloping the keyboard). Thus, it is the Examiner's position that Piazze teaches sterile covers at least to the same extent as applicant's covers are sterile.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the outer walls being sterile) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the rejection using Yanagisawa in view of Piazze uses improper hindsight reasoning. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Again, the Examiner further points out that she is relying on Yanagisawa primarily for the teaching of this broad concept of enclosing a keyboard with a flexible cover member so as to maintain the sterility of the keyboard. Yanagisawa is silent with respect to any details of how the enclosure would be formed. However, the Examiner

then relies on Piazza et al. to show a sterile cover member formed as an enclosure with the particular details of the envelope as recited. In view of this teaching, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to look to the cover of Piazza et al. as a means for providing the enclosure for the keyboard of Yanagisawa to provide a simple and easily replaceable sterile cover for better protection of the keyboard.

Applicant's also argues that the keyboard recited in claim 37 including an elongated opening along the long top edge portion provides unexpected results of easier enveloping of the keyboard and removal of the cover for disposal. The Examiner is not persuaded by this argument and maintains that one of ordinary skill in the art could easily determine the exact size and configuration of the enclosure and the particular edge in which the opening is formed so as to best envelop the object being covered.

In view of the above reasoning, the Examiner is not persuaded of any error in the above rejections.

### **Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on T-F 8:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*/ Leslie J. Evanisko /*  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
September 13, 2010